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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/250,083 02/15/99 DESSEN

A GI5341

EXAMINER

HM12/0913

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NASHED, N

ART UNIT

PAPER NUMBER

1652

DATE MAILED:

09/13/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/250,083

Applicant(s)  
Dessen et al.

Examiner  
Nashaat T. Nashed

Group Art Unit  
1652



☒ Responsive to communication(s) filed on Aug 7, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-29 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-29 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- |           |   |
|-----------|---|
| Group I   | Claims 1-7, drawn to a crystalline cPLA2, classified in Class 435, subclass 198.  |
| Group II  | Claims 8-15, drawn to a model/computer, classified in Class 702, subclass 19.   |
| Group III | Claims 16, 18, 20-25, drawn to a method of identifying compounds that modulate the activity of cPLA2, classified in Class 435, subclass 18.   |
| Group IV  | Claim 17, drawn to agonist or antagonist of the activity of cPLA2, classification unknown as the specification discloses no structural information for the claimed compound(s). Possible classifications could be Class 260 (organic compounds), Class 530 (peptide and proteins), Class 536 (carbohydrates), Class 423 (inorganic compounds), etc. |
| Group V   | Claims 19, drawn to a method of identifying mimics of cPLA2, classified in Class 435, subclass 18.  |
| Group VI  | Claim 26-28, drawn to inhibitors of cPLA2, classification unknown as the specification discloses no structural information for the claimed compound(s). Possible classifications could be Class 260 (organic compounds), Class 530 (peptide and proteins), Class 536 (carbohydrates), Class 423 (inorganic compounds), etc.                         |
| Group VII | Claim 29, drawn to substance that mimics the activity of cPLA2, classification classified in Class 435, subclass 198.   |

The inventions are distinct, each from the other because of the following reasons:

The crystalline cPLA2 of Group I, the agonist or antagonist of Group IV, the inhibitor of the activity of cPLA2 of Group VI, and the substances that mimics the activity of cPLA2 of Group VII are independent chemical compounds and require separate searches in the prior art.

The inventions of Groups I and those of Groups II, III, and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the different inventions are not disclosed as capable of use together.

Inventions of Group II and those of Groups III and V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with

another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the model/computer of Group II can be used in different methods such as in a method of modeling other lipases, whereas the method of identifying modulator (Group III) and mimics (Group V) of cPLA2 can be practiced with *in vivo* and/or *in vitro* assay methods.

The inventions of Group II and those of Groups IV, VI and VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the different inventions are not disclosed as capable of use together and have different function and effects.

Inventions of Group III and those IV and VI are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product of Groups IV and VI can be obtained by other methods such as *in vivo* and/or *in vitro* assay methods.

The inventions of Groups III and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the different inventions are independent methods having different products and are not disclosed as capable of use together.

The inventions of Groups III and VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the different inventions are not disclosed as capable of use together and they have different functions.

The inventions of Groups IV, and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the different inventions are not disclosed as capable of use together and they have different functions.

The inventions of Groups V, and VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the different inventions are not disclosed as capable of use together and they have different functions.

Inventions of Group V and VII are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product of Group VII can be obtained by other methods method such as *in vivo* and/or *in vitro* assay methods.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

A telephone call was made to Amy E. Mandragouras on August 22, 2k and August 28, 2k to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nashaat T. Nashed, Ph. D. whose telephone number is (703) 305-6586. The examiner can normally be reached Monday-Friday from 10:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy, can be reached on (703) 308-3804. The fax phone numbers for this Group are (703) 305-3014 and (703)308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.



Nashaat T. Nashed, Ph. D.  
Primary Examiner